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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,619	02/20/2004	Timothy M. Corcoran	149887	4142
38598 7590 05/26/2010 ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005				
EXAMINER SHEER, CRISTINA O				
ART UNIT PAPER NUMBER 3685				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/781,619

**Applicant(s)**

CORCORAN ET AL.

**Examiner**

CRISTINA SHERR

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Amendment filed November 25, 2009. Claims 1, 2, 8, and 21-22 are currently pending in this case. Claims 3-4, 6-7 and 9-20 had been previously canceled. Claims 1, 8, 21, and 22 are currently amended.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 25, 2009 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 2, 8, and 21-22, as currently amended, have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 8 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Regarding claim 8 -

7. In accordance with the M-or-T test, the claimed process must:

(1) be tied to a particular machine or apparatus (machine implemented); or (2) particularly transform a particular article to a different state or thing. A method claim that does not require machine implementation or does not cause a transformation will fail the test and should be rejected under § 101. However, the mere presence of a machine tie or transformation is not sufficient to pass the test.

8. When a machine tie or transformation has been identified, it must be further determined that the tie is to a particular machine or the particular transformation is of a particular article. Additionally, the particular machine tie or particular transformation must meet two corollaries to pass the test for subject matter eligibility. First, the use of the particular machine or transformation of the particular article must impose a meaningful limit on the claim's scope. So, a machine tie in only a field-of-use limitation would not be sufficient. Second, the use of the particular machine or the transformation of the particular article must involve more than insignificant "extra-solution" activity. If the machine or transformation is only present in a field-of-use limitation or in a step that is only insignificant "extra-solution" activity, the claim fails the M-or-T test, despite the presence of a machine or a transformation in the claim. *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) See also [http://www.uspto.gov/patents/law/comments/2009-08-25\\_interim\\_101\\_instructions.pdf](http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf).

9. In this case, claim 8 recites several method steps, including "providing a GCCIC system . . .", "providing a set of rules . . .", "receiving an indication . . .", "providing incentives . . .", "imposing fees . . .", and monitoring compliance . . .", without reciting who or what device is performing these steps. Thus the machine tie as recited in the

preamble represents mere extra-solution activity. Further, there is no transformation of a particular article recited in claim 8. For this reason, claim 8 is rejected under 35 U.S.C. 101.

10. Regarding claim 22 –

11. Claim 22 recites a computer program only. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claim recites only abstractions that are neither “things” nor “acts,” the claim is not within one of the four statutory classes of invention. Because the claim is not within one of the four statutory classes of invention, the claim is rejected under 35 U.S.C. §101.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 22 recites the limitation “. . . routine stored in the memory and executed by the processor” in the sixth limitation. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, II et al (US 6,240,295), in view of Kistner et al (US 5,983,655).

16. Regarding claim 1 –

17. Kennedy discloses a cargo container information Clearinghouse (fig1/22, col 3 In 34-40), comprising:

a system having a central cargo container information repository (col 4 In 25-40, col 3 In 34-40) wherein information related to transactions is processed and stored, the repository, comprising:

a processor section comprising a processor and a memory and including routines to operate the cargo container information clearinghouse, (col 4 In 40-55, col 3 In 34-40),

a transaction section that tracks transportation of goods transactions, recorded in the cargo container information clearinghouse, and a data section that records the information and provides an interface to users of the cargo container information clearinghouse; (e.g. col 4 In 56-65, col 6 In 1-10, col 6 In 28-32);

a set of rules for operation of the cargo container information clearinghouse; (e.g. col 4 In 40-55, col 7 In 4-45, col 7 In 65- col 8 In 16) and

wherein the processor section further includes environmental sensors that measure environmental data and a routine stored in the memory and executed by the processor to check compliance with the rules. (col 7 In 4-18, col 10 In 10-15, at col 4 In 49-55, col 5 In 60-67).

18. Kennedy discloses sensor systems which monitor the parameters of a truck trailer cargo container, including such environmental parameters as the temperature in a refrigeration unit. (col 7 In 4-18). Kennedy does not specifically disclose monitoring the environmental data and correlating the environmental data with one or more thresholds and set points to determine if the one or more thresholds and set points have been exceeded. Kistner, however, does, at, e.g. col 3 In 40-45, col 4 In 43-55, col 5 In 4-29. It would be obvious to one of ordinary skill in the art to combine Kennedy and Kistner, in order to monitor compliance with environmental rules in a logical and economical manner.

19. Note that having rules which include proposed and adopted rules, and having the said rules acknowledged or not by a government agency constitute nonfunctional descriptive data, and thus does not serve to further limit the claims. *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. Note also in Kennedy (col 4 In 40-55, col 7 In 4-45, col 7 In 65- col 8 In 16), where "reporting events" are governed by certain rules, such as change in location or temperature of the cargo, and these rules are equivalent to the government agency rules of the instant application.

20. Regarding claim 21 –

21. Kennedy discloses wherein the processor section further includes a routine for checking compliance with the rules. (at col 4 In 49-55, col 5 In 60-67)

22. Claims 2, 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Kistner et al (US 5,983,655), further in view of "Farmer's Mutual Benefit Association".

23. Regarding claim 2 –

24. Kennedy and Kistner disclose as discussed above. Specifically, Kennedy, at col 12 ln 5-20, discloses wherein the individual messaging unit, or the user unit receives messages regarding status, updating reporting limits, etc., via voice channel. This is an interface, which is in contact with the rules to be observed, and which reports updates or changes to the rules.

25. Kennedy does not specifically disclose a Mutual Benefit Association. However, "Farmer's Mutual Benefit Association" does.

([http://en.wikipedia.org/wiki/Farmers'\\_Mutual\\_Benefit\\_Association](http://en.wikipedia.org/wiki/Farmers'_Mutual_Benefit_Association)). Such associations include different entities which may or include both private and public sector entities, and they propose or make up rules to be followed by all of them. It would be obvious to one of ordinary skill in the art to combine Kennedy and Kistner with a Mutual Benefit Association, such as the one in "Farmer's" in order to have a ready-made set of rules to follow, for greater economy. See also

<http://delcode.delaware.gov/title18/c055/index.shtml>.

26. Regarding claims 8 and 22 –

27. Kennedy discloses a method for operation of a Cargo Container Information Clearinghouse (fig1/22, col 3 ln 34-40), the method being executed by a computer including a processor and a memory (col 4 ln 40-55, col 3 ln 34-40), and comprising:



providing a Cargo Container Information Clearinghouse system including a central information repository; (col 4 ln 25-40, col 3 ln 34-40)

providing a set of rules for operating the Cargo Container Information Clearinghouse system; (e.g. col 4 ln 40-55, col 7 ln 4-45, col 7 ln 65- col 8 ln 16)

and

monitoring compliance of cargo containers with the proposed rules by monitoring environmental data and correlating the environmental data with one or more thresholds and set points to determine if the one or more thresholds and set points have been exceeded. (col 7 ln 4-18, col 10 ln 10-15, at col 4 ln 49-55, col 5 ln 60-67).

28. Kennedy discloses sensor systems which monitor the parameters of a truck trailer cargo container, including such environmental parameters as the temperature in a refrigeration unit. (col 7 ln 4-18). Kennedy does not specifically disclose monitoring the environmental data and correlating the environmental data with one or more thresholds and set points to determine if the one or more thresholds and set points have been exceeded. Kistner, however, does, at, e.g. col 3 ln 40-45, col 4 ln 43-55, col 5 ln 4-29. It would be obvious to one of ordinary skill in the art to combine Kennedy and Kistner, in order to monitor compliance with environmental rules in a logical and economical manner.

29. Note that having rules which include proposed and adopted rules, and having the said rules acknowledged or not by a government agency constitute nonfunctional descriptive data, and thus does not serve to further limit the claims. *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32

USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. Note also in Kennedy (col 4 ln 40-55, col 7 ln 4-45, col 7 ln 65- col 8 ln 16), where "reporting events" are governed by certain rules, such as change in location or temperature of the cargo, and these rules are equivalent to the government agency rules of the instant application.

30. Kennedy does not disclose forming an association comprising commercial entities and government agencies as members; proposing rules for governing the association; receiving an indication that the proposed rules are acknowledged by a government- agency; providing incentives and programs for members of the association; and imposing fees on the organization. However, mutual benefit associations are old and well-known. See, e.g. "Farmer's Mutual Benefit Association" ([http://en.wikipedia.org/wiki/Farmers'\\_Mutual\\_Benefit\\_Association](http://en.wikipedia.org/wiki/Farmers'_Mutual_Benefit_Association)). Such associations include different entities which may or include both private and public sector entities, and they propose or make up rules to be followed by all of them, as well as impose fees and provide incentives and programs. See also <http://delcode.delaware.gov/title18/c055/index.shtml>.

31. It would be obvious to one of ordinary skill in the art to combine the teachings of Kennedy and Kistner with those of a mutual benefit association in order to obtain a structure and guidance for rules.

### ***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. Kochin (US 7,196,621) discloses a tracking system and associated method.

34. Smith et al (US 6,611,686) disclose a tracking control and logistics system and method.
35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.
36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR  
Examiner  
Art Unit 3685

/Calvin L Hewitt II/

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Supervisory Patent Examiner, Art Unit 3685